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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,009	11/20/2000	Keiichi Yamauchi	Q61858	7924

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

CHU, KIM KWOK

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,009

Applicant(s)

YAMAUCHI, KEIICHI

Examiner

Kim-Kwok CHU

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9, 11-14, 21-25, 27 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-9, 11, 21-25, 27 and 31-37 is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Remarks

1. Applicant's Amendment and Remarks filed on June 7, 2006 has been fully considered but it is not persuasive.

With respect to Claim 12, Applicant states that the prior art of Nagashima teaches that audio is monitored during the dubbing operation by decoder 41 (page 19 of the Remarks, lines 9 and 10). And therefore, the prior art of Nagashima fails to suggest at least the feature of outputting the audio information from the second information record medium to an external portion, when a reproduction start" (page 19 of the Remarks, lines 13-15). Accordingly, during the dubbing operation as illustrated in Nagashima's Fig. 1, an audio is read from medium 32 and transferred/copied to medium 2. The transferred audio goes through the encoder 15 before it is dubbed in medium 2. Since the encoder 15 is connected to the decoder 21, the transferred audio stream is outputted to terminal 26 as a monitoring signal Aout. In other words, the transferred audio is simultaneously recorded on medium 2 and monitored at terminal 26.

A similar audio dubbing and monitoring operation can be demonstrated when a CD music player is transferring music programs to a computer's hard drive. During the storing of the music programs in the computer, the transferred music can be heard from the computer's speaker system.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

3. Claims 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 12-14. For example, Nagashima teaches the following:

(a) With respect to claim 12, a first reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1; disc 32 is read; abstract, line 3); a recording device 3 for recording the reproduced audio information into a second information record medium 2 (Fig. 1; disc 2 is written on, abstract, line 7); a second reproducing device 3 for reproducing the audio information recorded in the second information record medium 2 (Fig. 1; recording device is also a reproducing device as it has ADPCM decoder and output 26); a controlling device 7 for controlling the first reproducing device 33 (Fig. 1), the recording device 3 and the second reproducing device 3 to output

the audio information (at decoder 23) from the second information record medium 2 to an external portion 26 (Fig. 1), when a reproduction start, which starts reproduction (read and decode in decoder 41) of audio information from the first information recording medium 32 by the first reproducing device 33 is instructed (Fig. 1), the audio information is reproduced from the second information record medium 2 and recorded on the second information record medium 2 at the same time (Fig. 1; reproducing 3 output audio while the audio is being written on the medium 2 because the encoder 15 and the decoder 21 are connected and function at the same time).

(b) With respect to claim 13, a converting device 15 for converting a form of the audio information (Fig. 1; audio encoding), wherein the controlling device 7 controls the converting device and the recording device to convert the form of the audio information and then record the audio information when recording the audio information reproduced by the first reproducing device 33 into the second information record medium 2 (Fig. 1; audio read from medium 32 and then encoded and transfer to medium 2).

(c) With respect to claim 14, a compressing device 15 for compressing the audio information; and an expanding device 21 for expanding the compressed audio information (Fig. 1; encoder is a compressing means), the controlling device 7 controls the

compressing device 15 and the recording device 3 to compress the audio information and then record the compressed audio information when recording the audio information, which is reproduced by the first reproducing device 33, into the second information record medium 2 (Fig. 1); and the controlling device 7 controls the second reproducing device 3 and the expanding device 21 to reproduce the compressed audio information, expand the reproduced audio information and then output the expanded audio information as a sound (Fig. 1; decoder expands the compressed audio).

Allowable Subject Matter

4. Claims 6-9, 11, 21-25, 27 and 31-37 are allowable over prior art.

5. The following is an Examiner's statement of reasons for the indication of allowable subject matter:

As in claims 6, 11, 21, 22, 27, 31 and 32, the prior art of record fails to teach or fairly suggest an information recording and reproducing apparatus having the following features:

(a) simultaneously record a portion of the audio information to the second information record medium at the set recording speed; and

(b) reproduce another portion of the audio information by reproducing another portion of the audio information from the second information record medium at the set reproducing speed.

As in claim 9, the prior art of record fails to teach or fairly suggest an information recording and reproducing apparatus having the following features:

(a) a controlling device for controlling a second reproducing device and a recording device so as to perform reproducing the recorded audio information from the second information record medium at the set reproducing speed in parallel to recording the audio information into the second information record medium at the set recording speed; and

(b) a compressing device for reproducing the recorded audio information from the second information record medium, compressing the reproduced audio information, and recording again the compressed reproduced audio information into the second information record medium.

As in claim 25, the prior art of record fails to teach or fairly suggest a compressing device for judging the audio information which is recorded in a non-compressed state from among the audio information recorded in the second information record medium, reproducing the judged audio information in the non-compressed state from the second information record medium, compressing the reproduced audio information by applying a predetermined compressing process onto the reproduced audio information, and recording again the compressed audio information into the second information record medium.

As in claims 33-35, the prior art of record fails to teach or fairly suggest an information recording and reproducing apparatus having the following features:

(a) a controlling device for controlling the first reproducing device and the second reproducing device to simultaneously reproduce the audio information in a non-compressed form from the first reproducing device faster than normal speed;

(b) record the audio information in a compressed form from which is converted from the non-compressed form by a compressing device; and

(c) reproduce the audio information in the compressed form from the second reproducing device at normal speed for playback.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action

7. Any comments considered necessary by applicant must be submitted no later than the payment of the Issue Fee and, to avoid processing delays, should preferably accompany the Issue Fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch, can be reached on (57) 272-7589.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

Kim-Kwok CHU

KC *8/15/06*
Examiner AU2627
August 15, 2006

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